

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ronald Lesser Confirmation No.: 3406  
Serial No.: 09/157,998 Art Unit: 3626  
Filed: September 22, 1998 Examiner: Morgan, Robert W.  
For: A SOFTWARE DEVICE TO FACILITATE CREATION OF MEDICAL RECORDS, MEDICAL LETTER, & MEDICAL INFORMATION FOR BILLING PURPOSES

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR CONTINUATION EXAMINATION, AND AMENDMENT**

Sir:

This communication is in response to the Final Office Action dated April 15, 2009 and the subsequent communications amongst Applicant, Applicant's attorney, and the Examiner. Applicant hereby requests continued examination of this application under 37 CFR 1.114.

Contemporaneously with this filing, Applicant is filing related RCE application materials. The Patent Office is authorized to charge any necessary excess claim and/or filing fees, and to credit any amounts due back to Applicant, to our PTO Deposit Account No. 08-2624.

Before the next action in this application, please amend the above-identified application as described below.

Remarks begin below, and amendments begin on page 6.

### **Certificate of Transmission**

I hereby certify that this correspondence is being transmitted via EFS to: Mail Stop: RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below:  
J.J. Mark Holland/  
J.J. Mark Holland, Reg. No. 32,416  
September 23, 2009  
DATE

## **REMARKS**

In addition to the further remarks herein, Applicant respectfully incorporates by reference the various remarks from Applicant's communications in the parent case (including those since the most recent Office Action such as from Applicant's June 15, 2009 Request for Reconsideration, August 24, 2009 Further Request for Reconsideration, and August 27, 2009 interview with the Examiner).

## **CLAIMS**

In the Final Office Action dated April 15, 2009, the Examiner rejected Claims 104-156 under 35 U.S.C. §103(a) as allegedly being unpatentable over (at least in part) the Evans (U.S. Patent No. 5,924,074) and Dorne (U.S. Patent No. 5,325,293) references.

In a series of telephone conferences with the Examiner following the August 27, 2009 interview, Applicant's attorney and the Examiner further negotiated (a) proposed amendments to currently pending Claim 112 and (b) language of a proposed new claim. In the most recent interview, the Examiner indicated that he expected the negotiated language to be allowable, but that he wanted to further search the claims prior to confirming their allowability, AND that any such further searching would need to be done in the context of a "new" application (rather than in the "after final" status of the then-negotiated claims). Accordingly, Applicant is continuing those negotiations (by pursing this RCE application) so that the Examiner can conduct even further searching on the claims.

Relevant to those claims, the limitation "a calculating means using said recorded responses to derive the Evaluation and Management billing code" was amended in Claim 112 and the limitation "a calculating means for using said data regarding said patient encounter to derive for the user said billing code" was included in the proposed new claim. Among other

things, neither Evans nor Dorne, nor any permissible combination of those references teach or suggest a calculating means for deriving a billing code from data recorded during a patient encounter. As discussed in the August 27, 2009 interview, Dorne simply teaches selecting an actual billing code from a list of codes presented to a user, and Evans merely teaches capturing and storing data. Neither reference discloses how to derive (calculate) a billing code based on recorded data from a patient encounter.

The Examiner further agreed that, rather than amend ALL of the other pending claims at this time, Applicant could simply formalize the negotiated claim language within this initial RCE filing (in the form of Claims 157 and 158, as explained below), and that upon further indication of allowance of those claims and/or further negotiation to that end, Applicant could THEN review and amend the other pending claims (and/or add further claims) in view of that formally allowed language. Accordingly, in the instant Request for Continued Examination, Applicant has added new Claim 157 to mirror the proposed amendments to pending Claim 112, and added new Claim 158 to mirror the proposed new claim (as discussed in the telephone conferences with the Examiner and Applicant's attorney).

Applicant respectfully submits that at least Claims 157 and 158 are now in condition for allowance, notice whereof is respectfully requested of the Examiner. Moreover, and as indicated above, upon an indicated allowance of Claims 157 and 158, Applicant is prepared to amend the remaining pending claims in view of those allowable claims, in order to move this application to issuance.

In addition and related to the claim amendments submitted herewith, Applicant respectfully submits that the original-filed specification contains sufficient support for the new claims, including the limitations "to derive the Evaluation and Management billing code" and

"to derive for the user said billing code" (in the "calculating means" clauses), in at least the following places:

- page 22, lines 3-6: "Based upon all of the sub-scores (derived from the individual elements of the examination) the system then requires the practitioner to come up with an overall "score" which reflects the level of effort and which itself is the code which will lead to billing and reimbursement." (emphasis added)
- page 26, lines 7-8: "The clinician is then expected to take the scoring from each of the sections just described and derive an overall score for the encounter with the patient." (emphasis added)
- page 27, lines 8-12: "A score (2b5, 2c3, 2d5) is derived from each of these three sections (2b, 2c, 2d). A final score is derived from 2b5, 2c3, 2d5. There are 64 possible combinations for each of the 15 types, for a total of 960 combinations. The rules for billing differ among these categories. The invention contains category specific algorithms to determine the appropriate billing level for the service provided." (emphasis added)

This filing is being made electronically. To the extent that any charges or credits are due and are not otherwise addressed, the Patent Office is authorized to charge or credit such amounts to the undersigned attorney's PTO Deposit Account 08-2624.

If the Examiner would like to discuss any remaining or new issues regarding this communication, the Examiner is invited to contact the undersigned representative of Applicant at (949) 718-6750.

Respectfully submitted,

Date: September 23, 2009

/J. Mark Holland/  
J. Mark Holland  
Reg. No. 32,416  
Alison L. Vass  
Reg. No. 63,078  
J. Mark Holland & Associates,  
a Professional Law Corporation  
3 San Joaquin Plaza, Suite 210  
Newport Beach, California 92660  
Telephone: 949-718-6750  
PTO Customer Number 21,259

JMH:alv

Z:\WinWord\TAMAR\P2630\RCE\_9\_23\_2009\2630\RCE\_9\_23\_2009.doc